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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/807,679	03/24/2004	Nagesh Kadaba	018360/268388	4421
826 7590 07/22/2009 ALSTON & BIRD LLP BANK OF AMERICA PLAZA 101 SOUTH TRYON STREET, SUITE 4000 CHARLOTTE, NC 28280-4000				
EXAMINER				
VETTER, DANIEL				
ART UNIT		PAPER NUMBER		
3628				
MAIL DATE		DELIVERY MODE		
07/22/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/807,679

Applicant(s)

KADABA, NAGESH

Examiner

DANIEL P. VETTER

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46, 48-54 and 59-71 is/are pending in the application.
- 4a) Of the above claim(s) 1-32 and 61-71 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 33-46, 48-54, 59 and 60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of the Claims

1. Claims 1-71 were previously pending. Claims 46, 48-54, 59 were amended, and claims 47, 55-58 were canceled in the reply filed April 24, 2009. Claims 1-46, 48-54, and 59-71 are currently pending, of which 1-32 and 61-71 are withdrawn from consideration.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 24, 2009 has been entered.

Response to Arguments

3. Applicant's arguments filed with respect to the rejections under § 103(a) have been fully considered but they are not persuasive. Applicant argues that two separate citations are provided for the "initial carrier computer system." Remarks, pages 20-22. Examiner respectfully disagrees. As a threshold matter, a "computer system" can consist of multiple interrelated elements. Moreover, while applicant has focused the argument on the container "memory devices" of column 8 and not the computer devices configured to interface with them. "Each hub is represented by a processing device (e.g., a computer configured to interface with memory devices 50A-N and/or 60). Morimoto, col. 8, lines 38-40 (emphasis added). Applicant similarly argues that these memory devices are responsible for performing the tasks such as communicating information, and thus Morimoto's disclosure is not sufficient to meet the claimed "computer system" limitations describing such communication. However, as shown in the citations below to col. 10 and col. 11, the central server and various carrier systems

also send and receive the information between one another. Applicant's arguments that Morimoto's network configuration (containing a central server in communication with various carrier hubs) is distinct and/or teaches away from the claimed computer systems (see Remarks, page 24) is moot in view of the rationale provided in the rejections below.

4. Applicant argues that Morimoto does not disclose the "shipper computer system" sending package data. Remarks, page 23. Examiner maintains that the shipper's information "is transmitted to central server" is sufficient to disclose to one of ordinary skill that the information is obtained from the broadly claimed "shipper computer system." Morimoto, col. 10, lines 22-24.

5. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

6. Examiner does not agree that Morimoto's disclosure is not sufficient to communicate with the scanning devices and instead only teaches the scanning device in communication with the container memory devices. See citations supplied in the rejections below.

7. Applicant argues that Morimoto does not teach the subsequent carrier tracking number. Remarks, page 27. The claims do not appear to require two different tracking numbers. Applicant cites to page 15 of the Specification which describes "first and second carrier tracking numbers." Remarks, page 27. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Moreover, while in Morimoto's preferred embodiment the same tracking number is

shared, it also acknowledges that this is not necessary to practice the system. See col. 15.

8. Applicant argues that in Thiel, "the intermediary's data processor is not a carrier computer system." Remarks, pages 28-30. Examiner considers Thiel's intermediary to be a carrier and thus its computer system to be a carrier computer system. See Fig. 4; paragraphs 0041, 0114, discussing the intermediary as a collection and distribution entity for postal matter (i.e., an "initial carrier"). Thiel does not specifically refer to the intermediary as a "carrier," however identity of terminology is not a requirement of a prior art reference. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). Moreover, even if this were not the case it still would have been obvious to incorporate the intermediary's functionality into Morimoto for the same reasons provided in the rejections below.

9. Applicant argues that Examiner did not present a convincing line of reasoning for combining the references. Remarks, page 30. Applicant notes, and Examiner recognizes, that simply because a claimed invention is a combination of old elements does not render it obvious. However, in addition to being old, the independent elements combined to form Applicant's invention can be combined by known methods, provide no added functionality than the constituent elements already served independently, and when combined would not yield any unpredictable results. These are the factual findings and rationale supporting the ultimate conclusion of obviousness. Applicant has neither disputed the merits of each of these particular findings nor supplied any rebuttal evidence to contradict them and, accordingly, the rejections are maintained.

10. Applicant argues that "there is no suggestion or teaching" and "there is no motivation to combine" the references. Remarks, page 31. An explicit motivation is no longer required in making a combination of references. The analysis provided in an obviousness rejection "need not seek out precise teachings directed to the challenged claim's specific subject matter" *KSR Int'l Co. vs. Teleflex, Inc.*, 550 U.S. 398, 411 (2007). "In determining whether the subject matter of a patent claim is obvious, neither the particular motivation nor the avowed purpose of the patentee controls." *Id.* at 413.

A reason for combining the references to arrive at Applicant's invention was provided in the rejection in accordance with the Supreme Court's decision in *KSR*.

11. Applicant argues both that there would be no reasonable expectation of success in combining the references and that the combination would not produce predictable results. Remarks, page 31. Statements by counsel regarding unexpected results are not evidence and therefore must be supported by an appropriate affidavit or declaration. MPEP § 716.01(c). This allegation is not supported by outside evidence or evidence already on the record. Arguments of counsel cannot take the place of factually supported objective evidence. See, e.g., *In re Huang*, 100 F.3d 135, 139-40, 40 USPQ2d 1685, 1689 (Fed. Cir. 1996); *In re De Blauwe*, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984). Similarly, the arguments of counsel cannot take the place of evidence in the record. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965).

12. Applicant's argument that the references are non-analogous art (Remarks, pages 31-32) has been fully considered but is unpersuasive. Applicant characterizes the cited references as a shipping system, a postage metering system, a billing system, a system for communication of shipping orders, and a bartering system. Examiner notes that Morimoto, Cordery, Delfer, and Thiel are all directed to shipping and delivery systems for mail and/or packages and are plainly within the same field of invention. Examiner acknowledges that Himmelstein's disclosure is principally concerned with a securities bartering system rather than a shipping system. However, both share similarities in accounting and financial transactions that can readily be implemented in both environments, and thus the disclosure is reasonably pertinent. Both are also classed in 705, for financial data processing systems. Examiner acknowledges that there are "clear differences" (as alleged in the Remarks, page 32) but disputes that these differences are significant enough in their nature to preclude the combination or inclusion of an escrow account. There is no evidence on the record or supplied by applicant that the financial data processing functions of Himmelstein and other bartering systems (specifically, the use of an escrow account) would be difficult or abnormal to implement within the context of a shipping system. Indeed, many shipping systems are

also configured to support bartering (e.g., Morimoto, the primary reference). One of ordinary skill in the art would therefore logically look to such bartering systems when configuring the accounting and payment functionalities of a shipping system that includes such features, thereby noting the usefulness of escrow accounts in payment schemes. Accordingly, examiner considers the cited references to be sufficiently analogous art and the rejections are maintained.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 33-35, 46, and 48-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morimoto, U.S. Pat. No. 7,035,856 (Reference A of the PTO-892 part of paper no. 20080528) in view of Cordery, et al., U.S. Pat. Pub. No. 2004/0093312 (Reference A of the PTO-892 part of paper no. 20081217).

15. As per claim 33, Morimoto teaches a computer system for routing delivery of a package by a plurality of carriers each having one of a plurality of physical delivery systems wherein delivery is requested by a shipper computer system, said computer system comprising:

an initial carrier computer system connected in electronic communication with the carrier physical delivery system of an initial one of the carriers and the shipper computer system (col. 9, lines 1-9), said initial carrier computer system: configured to obtain package information data from the shipper computer system, said package information data including a consignee address (col. 10, lines 22-24); configured to determine whether the consignee address is in a first classification or second classification (col. 9, lines 17-29), configured to instruct the initial carrier physical delivery system to deliver the package to the consignee address in response to the address being in a second

classification (col. 10, lines 39-45, 60-67, col. 11, lines 7-9), and configured to determine an intermediate location at which a subsequent one of the carriers is configured to receive the package in response to the address being in a first classification (col. 9, lines 23-26, col. 10, lines 60-67; col. 11, lines 7-10); and

a subsequent carrier computer system connected in communication with the initial carrier computer system and a subsequent one of the carrier physical delivery systems (col. 8, lines 35-40, col. 9, lines 1-9), said subsequent carrier computer system: configured to obtain the package information data, including the consignee address, and the intermediate location from the initial carrier computer system (col. 9, line 48, col. 11, lines 7-17); configured to receive instructions from the initial carrier computer system to receive the package at the intermediate location and complete delivery to the consignee address (col. 9, lines 48-50, col. 11, lines 7-17, 41-63); and configured to send the package information data, including the consignee address, and the intermediate location to the subsequent carrier physical delivery system and instructing the subsequent carrier delivery system to obtain the package at the intermediate location and complete delivery of the package to the consignee address (col. 11, lines 21-29, 55-63).

Morimoto does not explicitly teach that the first classification is an urban destination classification and the second is a rural destination classification; which is taught by Cordery (¶ 0081). Since each individual element and its function are shown in the prior art, albeit shown in separate references, the difference between the claimed subject matter and the prior art rests not on any individual element or function but in the very combination itself—that is, in the substitution of the urban/rural classifications in Cordery for the best-way by address classifications taught in Morimoto. Both determinations share similar characteristics and functions (i.e., determining the proper routing of a package in accordance with certain rules). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate urban/rural classifications because it is merely the simple substitution of one known element for another that could be implemented through routine engineering producing predictable results. Morimoto's system would still work for its intended purpose if one of

the intermediate destinations was specifically for hand-offs of mail to alternate rural carriers (as described in Cordery, ¶¶ 0081-83), and this modification would lead to the predictable result of a more robust shipping system. Examiner is interpreting an urban destination classification as one that is not specifically for rural delivery.

Examiner notes that Morimoto's network configuration (containing a central server in communication with various carrier hubs—see Fig. 2) is not identical to the claimed configuration of multiple carrier systems in communication with one another. However, based upon the level of skill displayed in the cited references (see, e.g., Fig. 10 and accompanying description), a skilled artisan would have recognized that the computer functions could be performed and the various information communicated directly without the intervention of a central server. Accordingly, it would have been prima facie obvious at the time of invention to perform the central server functionalities at the various shipper/carrier hub systems because this is merely a rearrangement of the data processing and transmitting features that could have been implemented through routine engineering producing predictable results.

16. As per claim 34, Morimoto in view of Cordery teaches the system of claim 33 as described above. Morimoto further teaches the package information data includes an initial carrier tracking number (col. 2, line 64) and wherein the initial carrier computer system is configured to communicate with a scanning device of the initial carrier physical delivery system to receive tracking data indicating detection of the initial carrier tracking number at the intermediate location by the scanning device (col. 3, lines 7-12), said initial carrier computer system also configured to electronically notify the subsequent carrier tracking system of arrival of the package at the intermediate location (col. 11, lines 12-27).

17. As per claim 35, Morimoto in view of Cordery teaches the system of claim 34 as described above. Morimoto further teaches the package information data also includes a subsequent carrier tracking number (col. 15, lines 3-9) and wherein the subsequent carrier computer system is configured to communicate with a scanning device of the subsequent carrier physical delivery system to receive tracking data indicating detection of the subsequent carrier tracking number at the consignee location (col. 11, lines 37-

41), said subsequent carrier computer system configured to notify the first carrier computer system of detection of the subsequent carrier tracking number at the consignee address (col. 11, lines 24-29). Examiner notes that, in Morimoto, the initial shipping company shares the tracking number with subsequent shipping companies (col. 15, lines 3-15). For all purposes in applying this reference, examiner is interpreting this to disclose an initial and subsequent tracking number, as the claims do not require the numbers to be different from one another.

18. As per claim 46, Morimoto teaches a method of routing delivery of a package by a plurality of carriers each having one of a plurality of physical delivery systems, said method of routing comprising: executing an initial carrier computer system (col. 9, lines 1-9; col. 16, lines 33-45), wherein the initial carrier computer system is adapted for: obtaining package information data, including a consignee address, from a shipper (col. 10, lines 22-24); determining whether the consignee address matches a first classification or a second classification (col. 9, lines 23-29); instructing the initial carrier physical delivery system to deliver the package to the consignee address in response to the consignee address matching the second classification (col. 10, lines 56-59, col. 11, lines 7-9); and determining an intermediate location at which a subsequent one of the carriers is configured to receive the package in response to the consignee address matching the first classification (col. 9, lines 23-26, col. 10, lines 61-63);

executing a subsequent carrier computer system connected in communication with the initial carrier computer system (col. 8, lines 35-40; col. 9, lines 1-9), wherein the subsequent carrier computer system is adapted for: obtaining the package information data, including the consignee address, and the intermediate location from the initial carrier computer system (col. 10, lines 61-65); receiving instructions from the initial carrier computer system to receive the package at the intermediate location and complete delivery to the consignee address (col. 10, lines 61-65; col. 11, lines 7-17); and sending the package information data, including the consignee address, and the intermediate location to the subsequent carrier physical delivery system (col. 10, lines 61-65; col. 11, lines 41-63) and instructing the subsequent carrier delivery system to

obtain the package at the intermediate location and complete delivery of the package to the consignee address (col. 11, lines 12-17, col. 12, lines 1-10).

Morimoto does not explicitly teach that the first classification is an urban destination classification and the second is a rural destination classification; which is taught by Cordery (§ 0081). Since each individual element and its function are shown in the prior art, albeit shown in separate references, the difference between the claimed subject matter and the prior art rests not on any individual element or function but in the very combination itself—that is, in the substitution of the urban/rural classifications in Cordery for the best-way by address classifications taught in Morimoto. Both determinations share similar characteristics and functions (i.e., determining the proper routing of a package in accordance with certain rules). It would have been *prima facie* obvious to one having ordinary skill in the art at the time of invention to incorporate urban/rural classifications because it is merely the simple substitution of one known element for another that could be implemented through routine engineering producing predictable results. Morimoto's system would still work for its intended purpose if one of the intermediate destinations was specifically for hand-offs of mail to alternate rural carriers (as described in Cordery, §§ 0081-83), and this modification would lead to the predictable result of a more robust shipping system. Examiner is interpreting an urban destination classification as one that is not specifically for rural delivery.

Examiner notes that Morimoto's network configuration (containing a central server in communication with various carrier hubs—see Fig. 2) is not identical to the claimed configuration of multiple carrier systems in communication with one another. However, based upon the level of skill displayed in the cited references (see, e.g., Fig. 10 and accompanying description), a skilled artisan would have recognized that the computer functions could be performed and the various information communicated directly without the intervention of a central server. Accordingly, it would have been *prima facie* obvious at the time of invention to perform the central server functionalities at the various shipper/carrier hub systems because this is merely a rearrangement of the data processing and transmitting features that could have been implemented through routine engineering producing predictable results.

19. As per claim 48, Morimoto in view of Cordery teaches the method of claim 46 as described above. Morimoto further teaches the initial carrier computer system is further adapted for obtaining an initial carrier tracking number (col. 2, line 64) and obtaining tracking data indicating detection of the initial carrier tracking number at the intermediate location in response to the use of a scanning device of the initial carrier physical delivery system (col. 3, lines 7-12).

20. As per claim 49, Morimoto in view of Cordery teaches the method of claim 48 as described above. Morimoto further teaches the subsequent carrier computer system is further adapted for notifying the subsequent carrier tracking system of detection of the initial carrier tracking number at the intermediate location (col. 11, lines 24-29).

21. Claims 36-43, 52-54, and 59-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morimoto in view of Cordery, et al. as applied to claims 35, 48, and 56 above, further in view of Delfer, III, U.S. Pat. No. 5,774,885 (Reference 1 of the IDS submitted 02/08/2008).

22. As per claim 36, Morimoto in view of Cordery teaches the system of claim 35 as described above. Morimoto further teaches the initial carrier computer system is further configured to combine the package information data with the tracking data indicating detection of the package at the intermediate location into an electronic data file using the initial carrier tracking number (col. 11, lines 24-29; Fig. 4), wherein the initial carrier computer system is configured to bill the subsequent carrier by transmitting the electronic data file to the subsequent carrier computer system (col. 11, lines 12-17, col. 15, lines 15-20). Morimoto does not teach that the data file is a billing manifest; which is taught by Delfer (col. 11, lines 13-20). Since each individual element and its function are shown in the prior art, albeit shown in separate references, the difference between the claimed subject matter and the prior art rests not on any individual element or function but in the very combination itself—that is, in the substitution of the billing manifests in Delfer for the data files used in Morimoto. Both elements share similar purposes and characteristics. It would have been prima facie obvious to one having

ordinary skill in the art at the time of invention to incorporate billing manifests because it is merely the simple substitution of one known element for another that could be implemented through routine engineering producing predictable results.

23. As per claim 37, Morimoto in view of Cordery and Delfer teaches the system of claim 36 as described above. Morimoto further teaches the initial carrier computer system is also configured to combine the tracking data indicating detection of the package at the consignee address with the package information data in the data file using the subsequent carrier tracking number (col. 11, lines 24-27, Fig. 4, col. 15, lines 10-15). Delfer further teaches the data file is a billing manifest as set forth above with respect to claim 36.

24. As per claim 38, Morimoto in view of Cordery and Delfer teaches the system of claim 37 as described above. Morimoto further teaches the subsequent carrier computer system is configured to display the data file for audit (col. 11, lines 21-24). Delfer further teaches the data file is a billing manifest as set forth above with respect to claim 36.

25. As per claim 39, Morimoto in view of Cordery and Delfer teaches the system of claim 37 as described above. Morimoto further teaches the subsequent carrier computer system is configured to compare the package information data with the tracking data indicating detection of the package at the consignee address to confirm delivery of the package on the electronic data file (col. 14, lines 50-62). Delfer further teaches the data file is a billing manifest as set forth above with respect to claim 36.

26. As per claim 40, Morimoto in view of Cordery and Delfer teaches the system of claim 39 as described above. Morimoto further teaches the initial carrier computer system is configured to obtain from the shipper computer system a compilation of package information data on a plurality of packages (col. 10, lines 45-46) and is further configured to periodically compare the package information data to the compilation of package information data to confirm receipt of the package information data from the shipper computer system (col. 13, lines 9-15).

27. As per claim 41, Morimoto in view of Cordery and Delfer teaches the system of claim 40 as described above. Morimoto further teaches the initial carrier computer

system is configured to electronically transmit at least one of the package information data, the tracking data and the electronic billing manifest to the shipper computer system or a consignee computer system (col. 11, lines 12-17).

28. As per claim 42, Morimoto in view of Cordery and Delfer teaches the system of claim 37 as described above. Morimoto further teaches the initial carrier computer system is further configured to generate cost of shipment data, including costs associated with delivery of the package by one or more participating carriers (col. 10, lines 36-39), generating an electronic invoice including the cost of shipment data and transmitting the electronic invoice to the shipper computer (col. 10, line 61 - col. 11, line 3; Fig. 4).

29. As per claim 43, Morimoto in view of Cordery and Delfer teaches the system of claim 42 as described above. Morimoto further teaches the cost of shipment data includes a cost of delivery to the intermediate location by the initial carrier and a cost of delivery to the consignee location by the subsequent carrier (col. 10, lines 39-45, 61-63).

30. As per claim 50, Morimoto in view of Cordery teaches the method of claim 48 as described above. Morimoto further teaches the initial carrier computer system is further adapted for constructing a data file by correlating, using the initial carrier tracking number, the package information data with the tracking data indicating detection of the initial carrier tracking number at the intermediate location (col. 11, lines 24-29; Fig. 4). Morimoto does not teach that the data file is a billing manifest; which is taught by Delfer (col. 11, lines 13-20). Since each individual element and its function are shown in the prior art, albeit shown in separate references, the difference between the claimed subject matter and the prior art rests not on any individual element or function but in the very combination itself—that is, in the substitution of the billing manifests in Delfer for the data files used in Morimoto. Both elements share similar purposes and characteristics. It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate billing manifests because it is merely the

simple substitution of one known element for another that could be implemented through routine engineering producing predictable results.

31. As per claim 51, Morimoto in view of Cordery and Delfer teaches the method of claim 50 as described above. Morimoto further teaches the subsequent carrier computer system is further adapted for obtaining a subsequent carrier tracking number and obtaining tracking data indicating detection of the subsequent carrier tracking number at the consignee address in response to the use of a scanning device of the subsequent carrier physical delivery system (col. 11, lines 24-27, Fig. 4, col. 15, lines 10-15).

32. As per claim 52, Morimoto in view of Cordery and Delfer teaches the method of claim 51 as described above. Morimoto further teaches the subsequent carrier computer system is further adapted for constructing the data file includes the subsequent carrier computer system being further adapted for correlating, using the subsequent carrier tracking number, the package information with the tracking data indicating detection of the subsequent carrier tracking number at the consignee address (col. 14, lines 59-67). Delfer further teaches the data file is a billing manifest as set forth above with respect to claim 50.

33. As per claim 53, Morimoto in view of Cordery and Delfer teaches the method of claim 50 as described above. Morimoto further teaches the subsequent carrier computer system is further adapted for comparing the electronic data file with the tracking data indicating detection of the subsequent carrier tracking number at the consignee address to confirm delivery of the package on the electronic data file (col. 14, lines 59-67). Delfer further teaches the data file is a billing manifest as set forth above with respect to claim 50.

34. As per claim 54, Morimoto teaches a computer program product for routing delivery of a package, the computer program product comprising a computer-readable storage medium having computer-readable program code portions stored therein (col. 16, lines 33-41), the computer-readable program code portions comprising: a first executable portion for obtaining package information data, including a consignee

address, from a shipper computer system (col. 10, lines 22-24); a second executable portion for determining whether the consignee address matches a first classification or a second classification (col. 9, lines 23-29); a third executable portion for instructing an initial carrier physical delivery system to deliver one of the packages to the consignee address in response to the consignee address matching the second classification (col. 10, lines 56-59, col. 11, lines 7-9); and a fourth executable portion for determining an intermediate location at which a subsequent one of the carriers is configured to receive the package in response to the consignee address matching the first classification (col. 9, lines 23-26, col. 10, lines 61-63); a fifth executable portion for sending the package information data and the intermediate location to the subsequent carrier physical delivery system (col. 10, lines 61-65; col. 11, lines 41-63) and instructing a subsequent carrier physical delivery system to obtain the package at the intermediate location and complete delivery of the package to the consignee address (col. 11, lines 7-17, col. 12, lines 1-2); a sixth executable portion for obtaining an initial carrier tracking number as part of the package information data (col. 2, line 64) and obtaining tracking data indicating detection of the initial carrier tracking number at the intermediate location using a scanning device of the initial carrier physical delivery system (col. 3, lines 7-12); a seventh executable code portion for constructing a data file by correlating, using the initial carrier tracking number, the package information data with the tracking data indicating detection of the initial carrier tracking number at the intermediate location (col. 11, lines 24-29; Fig. 4); and an eighth executable code portion for obtaining a subsequent carrier tracking number as part of the package information data and obtaining tracking data indicating detection of the subsequent carrier tracking number at the consignee address using a scanning device of a subsequent carrier physical delivery system (col. 11, lines 24-27, Fig. 4, col. 15, lines 10-15).

Morimoto does not explicitly teach that the first classification is an urban destination classification and the second is a rural destination classification; which is taught by Cordery (¶ 0081). Since each individual element and its function are shown in the prior art, albeit shown in separate references, the difference between the claimed subject matter and the prior art rests not on any individual element or function but in the

very combination itself—that is, in the substitution of the urban/rural classifications in Cordery for the best-way by address classifications taught in Morimoto. Both determinations share similar characteristics and functions (i.e., determining the proper routing of a package in accordance with certain rules). It would have been *prima facie* obvious to one having ordinary skill in the art at the time of invention to incorporate urban/rural classifications because it is merely the simple substitution of one known element for another that could be implemented through routine engineering producing predictable results. Morimoto's system would still work for its intended purpose if one of the intermediate destinations was specifically for hand-offs of mail to alternate rural carriers (as described in Cordery, ¶¶ 0081-83), and this modification would lead to the predictable result of a more robust shipping system. Examiner is interpreting an urban destination classification as one that is not specifically for rural delivery.

Morimoto does not teach that the data file is a billing manifest; which is taught by Delfer (col. 11, lines 13-20). Since each individual element and its function are shown in the prior art, albeit shown in separate references, the difference between the claimed subject matter and the prior art rests not on any individual element or function but in the very combination itself—that is, in the substitution of the billing manifests in Delfer for the data files used in Morimoto. Both elements share similar purposes and characteristics. It would have been *prima facie* obvious to one having ordinary skill in the art at the time of invention to incorporate billing manifests because it is merely the simple substitution of one known element for another that could be implemented through routine engineering producing predictable results.

Examiner notes that Morimoto's network configuration (containing a central server in communication with various carrier hubs—see Fig. 2) is not identical to the claimed configuration of multiple carrier systems in communication with one another. However, based upon the level of skill displayed in the cited references (see, e.g., Fig. 10 and accompanying description), a skilled artisan would have recognized that the computer functions could be performed and the various information communicated directly without the intervention of a central server. Accordingly, it would have been *prima facie* obvious at the time of invention to perform the central server functionalities

at the various shipper/carrier hub systems because this is merely a rearrangement of the data processing and transmitting features that could have been implemented through routine engineering producing predictable results.

35. As per claim 59, Morimoto in view of Cordery and Delfer teaches the product of claim 54 as described above. Morimoto further teaches the seventh executable code portion is further for correlating, using the subsequent carrier tracking number, the package information data with the tracking data indicating detection of the subsequent carrier tracking number at the consignee address (col. 14, lines 59-67).

36. As per claim 60, Morimoto in view of Cordery and Delfer teaches the product of claim 59 as described above. Morimoto further teaches a ninth executable code portion for comparing the electronic data file with the tracking data indicating detection of the subsequent carrier tracking number at the consignee address to confirm delivery of the package on the electronic billing manifest (col. 14, lines 59-67). Delfer further teaches the data file is a billing manifest as set forth above with respect to claim 57.

37. Claims 44 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morimoto in view of Cordery, et al. and Delfer, III as applied to claim 43 above, further in view of Thiel, U.S. Pat. Pub. No. 2002/0077847 (Reference B of the PTO-892 part of paper no. 20080528) and Himmelstein, U.S. Pat. Pub. No. 2002/0032643 (Reference C of the PTO-892 part of paper no. 20080528).

38. As per claim 44, Morimoto in view of Cordery and Delfer teaches the system of claim 43 as described above. Morimoto in view of Cordery and Delfer does not explicitly teach the initial carrier computer system is configured to control receipt of funds from the shipper computer system for payment of the invoice, debit an amount of the funds for shipment services provided by the initial carrier; which are taught by Thiel (¶¶ 0058-59, 82). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the above teachings of Thiel because this is merely a combination of old elements. In the combination each element would have served the same purpose as it did separately, and one skilled in the art would have recognized that the combination could be implemented through routine engineering

producing predictable results. Morimoto in view of Cordery and Delfer does not teach to deposit a remaining amount of the funds in an escrow account; which is taught by Himmelstein (§ 0119). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the above teachings of Himmelstein because this as well is merely a combination of old elements serving the same purpose that would produce only predictable results and could be implemented through routine engineering.

39. As per claim 45, Morimoto in view of Cordery, Delfer, Thiel, and Himmelstein teaches the system of claim 44 as described above. Thiel further teaches the subsequent carrier computer system is electronically connected to the account and is configured to withdraw funds from the account for shipping services provided by the subsequent carrier (§ 0126) and is also configured to compare the amount of the funds debited by the initial carrier to the electronic billing manifest (§§ 0128-29). Himmelstein further teaches the account is an escrow account (§ 0119). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the elements for the same reasons set forth above with respect to claim 44.

Conclusion

40. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL P. VETTER whose telephone number is (571)270-1366. The examiner can normally be reached on Monday through Thursday from 8am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/DPV/

/JOHN W HAYES/

Supervisory Patent Examiner, Art Unit 3628